

APPLICANT(S): DAVIDSON, Tal et al.
SERIAL NO.: 10/736,738
FILED: December 17, 2003
Page 5

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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Claims 1-28 are pending in this application. As a result of claim amendments herein, claims 1-28 will remain pending in this application.

35 U.S.C. § 102 Rejection

In the Office Action, the Examiner rejected claims 1-6, 9-15 and 19-28 under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 5,967,968 (Nishioka). Applicants respectfully traverse this rejection in view of the remarks that follow.

Nishioka discloses an endoscopic imaging system for viewing an object within a patient's body cavity including an endoscope for viewing an image of the object, an instrument channel extending therethrough, and a lens at the distal end adjacent the instrument channel; and an elongate probe configured to be inserted through the instrument channel and contact the object, the probe comprising a plurality of unevenly spaced graduations along its length, each graduation indicating a size factor used to scale the image produced by the endoscope. Nishioka also discloses to a method of determining the size of an object in a patient's body cavity including the steps of: generating an image of the object using an instrument; extending a probe having a series of unevenly spaced graduations from the instrument to the object; identifying the graduation on the probe visible in the image nearest to the instrument; and scaling the image viewed by the endoscope by a size factor corresponding to the identified graduation.

Applicants note that Examiner does not point out exactly where Nishioka allegedly teaches all the limitations of the independent claims, but instead refers to the claims and to a non-existent portion of the specification (column 11, lines 29-64, when column 11, which consists of claims, ends at line 26). However, even the other portions of the Nishioka reference fail to teach all the limitations of the amended claims.

APPLICANT(S): DAVIDSON, Tal et al.
SERIAL NO.: 10/736,738
FILED: December 17, 2003
Page 6

First, the Examiner alleges that Nishioka claims 1 and 2, teach every limitation of, e.g., independent claim 1. However, Nishioka claims 1 and 2 clearly refer to the probe 50 having graduations to scale the endoscope image from within the image. By contrast, independent claim 1 specifically requires that the scale be overlaid on the in vivo image, whereas the markings 52 on probe 50 are actually within the image.

In addition, the Examiner also refers to "a transparent piece, which is an optical dome, including a scale" that is used in the imaging device. Applicants are unsure as to the source of the Examiner's reference, as the word "dome" does not even appear in Nishioka. In any case, the transparent piece discussed at columns 4-5 of Nishioka is referred to as a "hardcopy measurement grid 62" for a particular size factor and has at most a linear scale 60, as shown in Fig. 2b of Nishioka, which is stated by Nishioka as "a specific absolute dimension for the object being imaged" (column 5, lines 4-5). By contrast, the amended claims of this application require that a non-linear scale be overlaid on the image, and this is clearly not taught by Nishioka.

As for claims, 2-6, 9-12, 14, 15, 20, 22-25 and 27, which depend from, directly or indirectly, one of amended independent claims 1, 13, 19, 21 and 26, and therefore include all the limitations of those claims. Therefore, Applicants respectfully assert that claims 2-6, 9-12, 14, 15, 20, 22-25 and 27 are likewise allowable. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections to amended independent claims 1, 13, 19, 21, 26 and 28 and to claims 2-6, 9-12, 14, 15, 20, 22-25 and 27 that are dependent thereon.

Applicants respectfully request reconsideration and withdrawal of the rejections of claims 1-6, 9-15 and 19-28.

35 U.S.C. § 103 Rejection

In the Office Action, the Examiner rejected claims 7, 8 and 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Nishioka in view of U.S. Patents Nos. 5,604,531 (Iddan) and 6,478,732 (Adachi). Applicants respectfully traverse this rejection.

Applicants note that claims 7, 8 and 16-18 are all dependent upon either independent claim 1 or independent claim 13 and include all of its limitations. As discussed above, Nishioka does not teach that the scale has at least two dimensions and, therefore, does not

APPLICANT(S): DAVIDSON, Tal et al.
SERIAL NO.: 10/736,738
FILED: December 17, 2003
Page 7

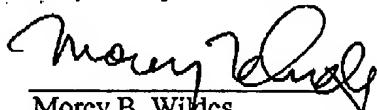
anticipate either independent claim 1 or independent claim 13. In addition, neither Iddan nor Adachi, either alone or in combination, teaches this missing claim feature, namely that the scale has at least two dimensions, and the Examiner does not assert that Iddan or Adachi teach or suggest.

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,



Morey B. Wildes
Attorney/Agent for Applicant(s)
Registration No. 36,968

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Pearl Cohen Zedek Latzer, LLP
1500 Broadway, 12th Floor
New York, NY 10036
Tel: (646) 878-0800
Fax: (646) 878-0801